



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,626	05/18/2004	John Elasic	12051-00001-US	3625

23416 7590 04/06/2007  
CONNOLLY BOVE LODGE & HUTZ, LLP  
P O BOX 2207  
WILMINGTON, DE 19899

EXAMINER
----------

CLEMENT, MICHELLE RENEE

ART UNIT	PAPER NUMBER
----------	--------------

3641

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/709,626	ELASIC, JOHN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michelle (Shelley) Clement	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1/3/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 1/3/07 have been fully considered but they are not persuasive. Davey discloses the shield comprising the viewing window formed from the bullet proof glass, the reference of Baker is relied upon for the teaching of a frame for mounting a firearm, it is the suggesting of Baker of the frame that is combined with the shield as disclosed by Davey that forms the rejections of the claims. Furthermore it is noted the [a) statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. Therefore the statements that the frame is intended "for mounting a firearm" does not serve to patentably distinguish the claimed structure over that of the reference as long as the structure of the reference is capable of thus performing. Baker teaches that "the support/handle 40 comprises a pair of canted strips, preferably formed of spring steel configured to provide a mount or rest for the forward end of the long gun", it is irrelevant that the mount of Baker is used in conjunction with the user's hand. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Art Unit: 3641

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Additionally applicant's arguments do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. The mount of Baker shows a firearm mounted to the shield and dischargeably operable when so mounted and when the shield is held by the handle in front of at least a portion of the user's body.

Applicant's remaining arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

2. The amendment filed 9/12/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: **means** for viewing, **means** for carrying or holding and **means** for mounting.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3641

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed did not describe the **means** for viewing, **means** for carrying or holding or the **means** for mounting.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 8, 10-12, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davey (US Patent # 2,316,055) in view of Baker (US Patent # 6,886,446). Davey discloses a ballistic shield comprising a shield having a front face and a reverse face and formed of a ballistic material, a viewing window through the shield, handles associated with the shield that can be used for carrying the shield or holding the shield in front of at least a portion of a user's body or used as a forearm cuff and multiple firearms (not shown see page 2, lines 40-55 which each discharge in a different direction) mounted to the shield and dischargeably operable when so mounted, wherein the firearm is mounted for discharge in a direction at an angle outwardly from the front face of the shield, the firearm is dischargeably operable when the shield

Art Unit: 3641

is held in front of at least a portion of the user's body. The firearm is a pistol. The firearms are mounted so that they discharge in a plurality of directions including a direction substantially perpendicular to the front face of the shield. The shield can be employed and the firearm can be discharged with a single arm (presumably depending on the strength and dexterity of the user). Multiple firearms are mounted when shields are combined, it is inherent that the firearms can be discharged in any direction outward from the face of the shield including substantially perpendicular and substantially parallel to the shield. Although Davey does not expressly disclose the shield including a frame attached to the shield, Baker does. Baker teaches a hand-held ballistic shield including a frame attached to the shield that has a support/handle (reference 40) the ability to mount a firearm furthermore having the ability for the firearm to be mounted to the shield and be dischargeably operable when so mounted and when the shield is held in front of at least a portion of a user's body. Davey and Baker are analogous art because they are from the same field of endeavor: ballistic shields. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the frame attached to the shield as suggested by Baker with the shield as disclosed by Davey. The suggestion/motivation for doing so would have been to obtain a hand-held ballistic shield that a user could easily position both the shield and firearm with one hand as suggested by Baker at column 6, lines 10-30). It is noted that the [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In

Art Unit: 3641

re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Davey and Baker discloses the claimed invention except for the specific ballistic material selected from the claimed group or the material of the viewing window specifically selected from the claimed group. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the specific materials in making the shield, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and Davey discloses that such known materials are used in the construction of the shield. *In re Leshin*, 125 USPQ 416.

7. Claims 6, 7, 13, 14, and 16 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey and Baker as applied to claim 1 above, and further in view of Resnick (US Patent # 6,272,781). Although neither Davey nor Baker expressly disclose a taser gun and battery and various sensors and communications devices mounted to the shield, Resnick does. Resnick teaches a ballistic shield comprising a shield having a front face and a reverse face and formed of

Art Unit: 3641

a ballistic material; a handle associated with the shield and a taser gun mounted to the shield and dischargeably operable when so mounted. Although Resnick does not expressly mention the battery it is inherent that a power source (i.e. battery) would be present, since the taser gun would not operate without such a source. The shield further comprising a disabling sensor the disable the firing devices in response to a predetermined signal or a predetermined absence of a signal. The shield comprising a plurality of communication accessories mounted to the shield selected from the claimed group, and further comprising a plurality of light sources. Davey, Baker and Resnick are analogous art because they are from the same field of endeavor: protective shields. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the taser gun as taught by Resnick with the shield taught by Davey as modified by Baker. The suggestion/motivation for doing so would have been to obtain a shield that provided the additional protections and advantages as suggested by Resnick.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey and Baker as applied to claim 1 above, and further in view of Lobdell (US Patent # 1,227,544). Although neither Davey nor Baker expressly disclose a mirror associated with the viewing window, Lobdell does. Lobdell teaches a mirror that can be mounted on a firearm to increase the field of vision. Lobdell, Baker and Davey are analogous art because they are from similar problem solving areas: protection while firing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the mirror as taught by Lobdell with the firearms and shield taught by Davey and modified by Baker. The suggestion/motivation for doing so would have been to obtain a shield that had an extended field of view.

Art Unit: 3641

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davey, Baker and Resnick. See ¶ above.

10. Claims 1-5, 8, 10-12, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davey (US Patent # 2,316,055) in view of any one of Korn (US Patent # 1,308,286) or Molvig (US Patent # 1,301,293). Davey discloses a ballistic shield comprising a shield having a front face and a reverse face and formed of a ballistic material, a viewing window through the shield, handles associated with the shield that can be used for carrying the shield or holding the shield in front of at least a portion of a user's body or used as a forearm cuff and multiple firearms (not shown see page 2, lines 40-55 which each discharge in a different direction) mounted to the shield and dischargeably operable when so mounted, wherein the firearm is mounted for discharge in a direction at an angle outwardly from the front face of the shield, the firearm is dischargeably operable when the shield is held in front of at least a portion of the user's body. The firearm is a pistol. The firearms are mounted so that they discharge in a plurality of directions including a direction substantially perpendicular to the front face of the shield. The shield can be employed and the firearm can be discharged with a single arm (presumably depending on the strength and dexterity of the user). Multiple firearms are mounted when shields are combined, it is inherent that the firearms can be discharged in any direction outward from the face of the shield including substantially perpendicular and substantially parallel to the shield. Although Davey does not expressly disclose the shield including a frame attached to the shield, both Korn and Molvig do. Both Korn and Molvig each individually teach a ballistic shield that has the ability to be held by hand including a frame attached to the shield that has the intended use of mounting a firearm attached to the shield, the shield furthermore

Art Unit: 3641

having the ability for the firearm to be mounted to the shield and be dischargeably operable when so mounted and when the shield is held in front of at least a portion of a user's body. Davey Korn and Molvig are analogous art because they are from the same field of endeavor: ballistic shields. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the frame attached to the shield as suggested by either Korn or Molvig with the shield as disclosed by Davey. The suggestion/motivation for doing so would have been to obtain a hand-held ballistic shield that a user could easily position both the shield and firearm with one hand. It is noted that the [a) statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Davey and either Korn or Molvig disclose the claimed invention except for the specific ballistic material selected from the claimed group or the material of the viewing window specifically selected from the claimed group. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the specific materials in making the shield, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and Davey discloses that such known materials are used in the construction of the shield. *In re Leshin*, 125 USPQ 416.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drackett (US Patent # 6,845,701) in view of Resnick (US Patent # 6,272,781) and Seely (US Patent # 33,854). Drackett discloses a portable ballistic shield comprising a shield having a front face and a reverse face formed of a ballistic material, a viewing window through the shield, a handle associated with the shield (the handle has the ability of being used to carry the shield OR hold the shield in front of a user's body), a frame for mounting a firearm attached to the shield and a firearm mounted to the shield and dischargeably operable when so mounted, wherein the firearm is mounted for discharge in a direction at an angle outwardly from the front face of the shield. Although Drackett does not expressly disclose a second firearm various sensors and communications devices and one or more light sources mounted to the shield, Resnick does. Resnick teaches a ballistic shield comprising a shield having a front face and a reverse face and formed of a ballistic material; a handle associated with the shield and a taser gun mounted to the shield and dischargeably operable when so mounted. Although Resnick does not expressly mention the battery it is inherent that a power source (i.e. battery) would be present, since the taser gun would

Art Unit: 3641

not operate without such a source. The shield further comprising a disabling sensor to disable the firing devices in response to a predetermined signal or a predetermined absence of a signal. The shield comprising a plurality of communication accessories mounted to the shield selected from the claimed group, and further comprising a plurality of light sources. Drackett and Resnick are analogous art because they are from the same field of endeavor: protective shields. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the taser gun as taught by Resnick with the shield taught by Drackett. The suggestion/motivation for doing so would have been to obtain a shield that provided the additional protections and advantages as suggested by Resnick. Although neither Drackett nor Resnick expressly disclose the shield having a second firearm (i.e. ballistic firearm) mounted to the shield so as to discharge in a direction that is different from a discharge direction of the first firearm, Seeley does. Seeley teaches a shield having multiple firearms mounted to the shield, each one having a different discharge direction in order to cover a broader range. Drackett, Resnick and Seeley are analogous art because they are from the same field of endeavor: ballistic shields. Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the multiple firearms mounted to the shield as suggested by Seeley with the portable ballistic shield as disclosed by Drackett and modified by Resnick. The suggestion/motivation for doing so would have been to obtain a defensive shield that had a broader range and it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of

Art Unit: 3641

intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MICHELLE CLEMENT  
PRIMARY EXAMINER